

**REMARKS**

By this Amendment, Applicants have amended claims 1, 22-23, 25-26, and 28-29. No new matter has been added.

Upon entry of this Amendment, claims 1-30 will remain pending and under current examination. In the Office Action <sup>1</sup> mailed November 24, 2008, the Examiner rejected claims 1 and 22 under 35 U.S.C. § 101 as being directed to non-statutory subject matter; rejected claim 23 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention; and rejected claims 1-30 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,970,478 to Walker et al. ("Walker") in view of U.S. Patent No. 6,324,524 B1 to Lent et al. ("Lent").

Applicants respectfully traverse the above rejections for reasons presented as follows.

**Rejection of Claims 1 and 22 Under 35 U.S.C. § 101**

The Office Action asserted that claims 1 and 22 are directed to non-statutory subject matter. Office Action, p. 3. In response to this rejection, and without conceding to the Office Action's assertions regarding alleged non-statutory matter, Applicants have amended claims 1 and 22 to recite a method implemented using a computer.

Applicants submit that the amendments overcome the 35 U.S.C. § 101 rejection because claims 1 and 22 are tied to a particular machine, the computer. Independent

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<sup>1</sup> The Office Action contains statements characterizing the related art and the claims. Regardless of whether any such statements are specifically identified herein, Applicants decline to automatically subscribe to any statements in the Office Action.

claims 1 and 22 are therefore allowable as amended. Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 101 rejection.

**Rejection of Claim 23 Under 35 U.S.C. § 112, Second Paragraph**

The Office Action asserted that the terminology “unselectable” is unclear. Office Action, p. 3. In response to this rejection, and without conceding to the Office Action’s assertions, Applicants have amended claims 22-23, 25-26, and 28-29 to recite their subject matter more clearly. Applicants therefore respectfully request withdrawal of this rejection.

**Rejection of Claim 1-30 Under 35 U.S.C. § 103(a)**

Applicants respectfully traverse the rejection of claims 1-30 under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Lent.

The Office Action has not properly resolved the *Graham* factual inquiries, as required to establish a framework for an objective obviousness analysis. See M.P.E.P. § 2141(II), citing to *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), as reiterated by the U.S. Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, 82 USPQ2d 1385 (2007). In particular, the Office Action has not properly ascertained the differences between the claimed invention and the prior art, at least because the Office Action has not correctly interpreted the prior art and considered both the invention and the prior art as a whole. See M.P.E.P. § 2141(II)(B).

As the Office Action admitted, Walker does not disclose Applicants’ claimed “determining, using the computer, if the applicant accepts the at least one first financial account product” and “if the applicant accepts the at least one first financial account product, providing, to the applicant, selectable options and at least one inputable option

for further defining predetermined features of the recommended at least one first financial account product,” as recited in amended independent claim 22. Office Action, p. 6. In addition, Applicants point out that Walker also fails to disclose Applicants’ claimed “determining, using the computer, if the applicant accepts the at least one first financial account product” and “if the applicant accepts the at least one first financial account product, providing to the applicant a plurality of selectable options for further defining predetermined features of the recommended at least one first financial account product,” as recited in independent claim 1, for the some reason as claim 22.

The Office Action alleged that Lent discloses the above-quoted elements of Applicants’ independent claims 1 and 22. Office Action, p. 6. Applicants respectfully disagree. Lent does not cure the deficiencies of Walker. For example, Lent discloses that “in a step 1006, a set of offers is derived from the credit report data and other applicant information stored in the application object” and “[in] a step 1008, the set of offers is displayed.” Lent, col. 13, lines 64-67. That is, the offers have no selectable options because they have been determined from stored information before the offers are displayed to the applicant. Fig. 12 of Lent illustrates a display provided to the applicant for presenting multiple offers. See Lent, col. 16, lines 16-32. In Fig. 12, each offer is accompanied by a “Required Balance Transfer” amount which is required for that offer to be accepted. See Lent, Fig. 12 and col. 16, lines 23-24. Further, Lent discloses that “[once] an offer is selected, the process of acquiring the required balance transfer in real-time from the applicant is executed.” Lent, col. 16, lines 29-31. That is, the applicant can only select an offer from a set of offers which have all their features predefined before the applicant sees them. And in order to fulfill the balance transfer

requirement to accept the already determined offer, the applicant “is given an opportunity to indicate a balance transfer by selecting one of the accounts and indicating the amount to be transferred.” Lent, col. 16, lines 58-60.

The Office Action alleged that because Lent’s system “notes the selected offer and balance transfer amount” and allows the user to specify an account and amount; Lent discloses “determining, using the computer, if the applicant accepts the at least one first financial account product” and “if the applicant accepts the at least one first financial account product, providing to the applicant a plurality of selectable options for further defining predetermined features of the recommended at least one first financial account product,” as recited in claim 1. See Office Action, p. 6. Applicants respectfully disagree. Applicants point out that the Office Action mischaracterized Lent. As explained above, Lent’s “selecting one of the [balance transfer] accounts” and “indicating the amount to be transferred” are steps required to accept an already determined offer. Lent, Col. 16, lines 58-60. However, the features of the selected offer can not be further defined by the “selecting” and “indicating” steps. For example, in Fig. 12 of Lent, offer 3 (1208) has an interest rate of 8.9%, annual fee of \$0, a credit limit of \$10,000, and a required balance transfer of \$4,000. Regardless of what account(s) and amount(s) are used to meet the \$4,000 required balance transfer, the features of offer 3 (e.g., the rate, annual fee, credit limit, and required balance transfer) can not be selected and changed by the applicant. Therefore, the applicant can not further define the features of the selected offer after making the selection, and Lent does not teach or suggest claim 1’s recitation that “if the applicant accepts the at least one first financial account product, providing to the applicant a plurality of selectable options for further

defining predetermined features of the recommended at least one first financial account product.”

Due at least to misinterpreting Lent, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the sizable differences between the prior art and the claimed invention. In view of the reasoning presented above, Applicants therefore submit that independent claim 1 is not obvious over Walker and Lent, whether taken alone or in combination. Independent claim 1 is therefore allowable.

Independent claims 6, 11, 22, 25 and 28, while different in scope, recite elements similar to independent claim 1, and are allowable for the same reasons as claim 1. Dependent claims 2-5, 7-10, 12-21, 23-24, 26-27, and 29-30 are allowable at least by virtue of their respective dependence from base claim 1, 6, 11, 22, 25 or 28, as well as by virtue of reciting additional features not taught nor suggested by the cited references. Accordingly, Applicants request the withdrawal of the 35 U.S.C. § 103(a) rejection.

### **Conclusion**

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

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By: William J. Brogan  
William J. Brogan  
Reg. No. 43,515